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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/674,468

10/01/2003

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A8460

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23373 7590 10/31/2007
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EXAMINER

SALUJA, DALPREET S

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

10/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/674,468 | Applicant(s) GOMES ET AL. | |
| | Examiner Dalpreet S. Saluja | Art Unit 3622 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>12/31/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The Information Disclosure Statement filed on **31 November 2003** has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Status of Claims

2. This action is in reply to the non-provisional application filed on 01 October 2003.
3. Claims 17 and 18 have been added by preliminary amendment on 22 March 2004.
4. Claims 1-18 are currently pending, have been examined, and are **rejected**.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 1, 2, 4-13, and 17 are rejected** under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As per Claims 1 and 17, the limitations recite an abstract idea and therefore are unpatentable. It has been held that the question in determining the patentability of a method is whether it is a process within the meaning of the Patent Act: " 'Abstract ideas' ... fall beyond the broad reaches of patentable subject matter under §101" *In re Comiskey, Fed. Cir. 2007*. However, if the abstract idea, as employed in a process, is embodied in a machine, manufacture, or

Art Unit: 3622

composition of matter, then it may satisfy the 101 burden. *In re Comiskey, Fed. Cir. 2007*. Since claims 2 and 4-13 are dependent on Claim 1, they are rejected for the same reasons.

7. **Claims 6 and 9-13** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The instant claims recite the following limitations:

- **Claim 6:** *wherein the qualifying status must take place in one 24-hour trip to the casino*
- **Claim 9:** *wherein the first number of points awarded and the additional points awarded are doubled for the player during a designated time period when either of the first or at least one second game is played.*
- **Claim 10:** *where the designated time is on a weekday*
- **Claim 11:** *where the designated time is after midnight*
- **Claim 12:** *where the designated time is on a birthday of the player*

None of these claims are a machine, manufacture, process, or composition of matter.

Certain types of descriptive material, such as music, literature, art, photographs, and mere arrangements or compilations of facts or data, without any functional

interrelationship do not fall within one of the four statutory categories. MPEP §2106.01.

These generally constitute non-descriptive functional material and, therefore, are given no patentable weight.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. **Claims 2 and 14 - 16** are ***rejected*** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. **Claim 2** recites the limitation "wherein the first game and the at least one second game are slot machines." Claim 1, from which Claim 2 depends, recites in the preamble "a method of rewarding players of a table game." Since Applicant is limiting the casino games to "table games" in Claim 1, it is unclear how the first and second games can be slot machine games. For purposes of this examination, the Examiner interprets this claim as including all casino games.

11. **Claim 14** recites the limitation "the promotional period" in lines 12-13. There is insufficient antecedent basis for this limitation in the claim. Since claims 15 and 16 are dependent on the instant claim, they are ***rejected*** for the same reasons.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant.

Art Unit: 3622

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

13. **Claims 1-5, 7, 8, 14, 17, and 18** are ***rejected*** under 35 U.S.C. 102(b) as being anticipated by Boushy, Patent No. US 5,761,647 issued on 2 June 1998 ("Boushy").

14. **Claims 1 and 17:**

- Boushy teaches:
 - *establishing a first casino game to be part of a reward program*
(see at least column 2, line 64 – column 3, line 3 wherein "gaming activities" reads on *casino game*)
 - *placing a wager on the first game by a player* (see at least column 11, lines 28 - 32)
 - *recording the first number of points* (see at least column 11, lines 3-5)
 - *accumulating additional points that are added to the first number of points so as to place the player at a first reward level* (see at least paragraph column 12, lines 29 – 32 wherein the tiered point system reads on *added to the first number of points* and column 3, lines 10 –13 wherein the points can be used for gifts and services)

Art Unit: 3622

- *accumulating additional points by playing the first game or at least one second game the additional points being recorded so that they are added to the points used to reach the first reward level so as to form a cumulative amount of points (see at least paragraph column 12, lines 29 – 32 wherein the tiered point system reads on *added to the first number of points* and column 3, lines 10 – 13 wherein the points can be used for gifts and services)*
- *further adding to the cumulative amount of points so as to exceed a second predetermined amount of points which puts the player at a second reward level (see at least paragraph column 12, lines 29 – 32 wherein the tiered point system reads on *added to the first number of points* and column 3, lines 10 – 13 wherein the points can be used for gifts and services)*
- Boushy does not explicitly teach:
 - *awarding a first number of points to the player (see at least column 12; lines 5 – 15 wherein)*
 - *presenting the player with a choice to choose a first gift after reaching the first reward level (see at least Figure 3)*
 - *after reaching the second reward level, presenting the player with a choice to choose a second gift (see at Figure 3).*

- However, under the principles of inherency, since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention.

MPEP § 2112.02. As evidence tending to show inherency, it is noted that under a tiered point system, a first number of points would have to be awarded in order to initiate the reward system. Furthermore, where gifts are presented, the initial gift presented to the player would be the “first gift” and subsequent gifts would be the second, third, and fourth gifts (see at least column 12, lines 29 – 32).

15. **Claim 2:** Boushy teaches the method of Claim 1 as set forth above. Boushy further teaches *wherein the first game and the at least one second game are slot machines* (see at least column 1, lines 23 – 27).

16. **Claim 3:** Boushy teaches the method of Claim 1 as set forth above. Boushy further teaches *the use of a data card either preceding or following said placing of a wager so as to communicate information of the player* (see at least column 1, lines 23 - 27).

17. **Claim 4:** Boushy teaches the method of Claim 1 as set forth above. Boushy does not explicitly teach *wherein the second gift is of a greater monetary value than the first gift* (see at least paragraph 0050). However, under the principles of inherency, since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. MPEP § 2112.02. As evidence tending to show inherency, it is noted that each point represents a

Art Unit: 3622

monetary value to the player (see at least column 3, lines 13 – 16) and in a tiered point system, the higher tiered points would have a greater monetary value and, therefore, provide more valuable gifts (see at least column 12, lines 29 – 32).

18. **Claim 5:** Boushy teaches the method of Claim 1 as set forth above. Boushy does not explicitly teach *wherein said player must first obtain a qualifying status before being eligible to reach the first reward level, the qualifying status being obtained by acquiring a predetermined amount of points*. However, the limitation of this claim is inherent for the same reasons as stated above with Claim 4 and, therefore, is rejected for the same reason.

19. **Claim 7:** Boushy teaches the method of Claim 1 as set forth above. Boushy does not explicitly teach *wherein after reaching a predetermined reward level, which is higher than said second reward level the player can choose from limited edition gifts and standard gifts, wherein the number of standard gifts is greater than the number of limited edition gifts*. However, the limitation of this claim is inherent for the same reasons as stated above with Claim 4 and, therefore, is rejected for the same reason.

20. **Claim 8:** Boushy teaches the method of Claim 1 as set forth above. Boushy does not explicitly teach *wherein said method is practiced for only a limited amount of days at the casino*. However, under the principles of inherency, since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. MPEP § 2112.02. As evidence tending to show inherency, and in view of the lack of a specific definition of a “limited amount of

days,” it is noted that there are only a limited amount of days in a year. Therefore, the method could only be practiced within a limited amount of days.

21. Claims 14 and 18:

- Boushy teaches:
 - *a plurality of casino games* (see at least column 2, line3s 24 – 27 disclosing the use of a customer cards with a plurality of games such as slots and gaming tables)
 - *an input device for receiving information pertaining to a player* (see at least column 1, lines 18 –27 wherein gaming cards are specific to each customer and inputting into a card reader at each gaming table)
 - *a compensation machine* (see at least column 8, lines 18 – 25 wherein it is determined if a player qualifies for a “comp”)
 - *means for outputting points of the player from the plurality of casino games to said compensation machine* (see at least column 1, lines 18 – 21 wherein the membership card provides the player an account holding their accumulated points)
 - *means for viewing at the compensation machine, a status of the player said status including a total amount of points that the player has accumulated; and an amount of points needed to reach at least one of a plurality of reward levels wherein said total amount of points is representative of all points acquired*

during the promotional period and if the player has surpassed one of said plurality of reward levels, the total amount of points is equal to the amount of points needed to surpass said one of said plurality of reward levels plus the amount of points obtained in addition to the amount of points needed to surpass said one of said plurality of reward levels (see at least Figure 3 wherein the casino management system includes Kiosks which in at least column 8, lines 15 – 18 it is disclosed that players can check on their activity points or comp availability)

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. **Claims 6, 9-13, 15, and 16 are *rejected*** under 35 U.S.C. 103(a) as being unpatentable over Boushy.

24. **Claim 6:** Boushy teaches the method of Claim 5 as set forth above. Boushy does not teach *wherein the qualifying status must take place in one 24-hour trip to the casino*. However, since a casino would want to provide an incentive for a player to visit and play again as soon as possible to increase the patronage at the venue, it would

have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to add the instant limitation with the teachings of Boushy.

25. **Claim 9:** Boushy teaches the method of Claim 5 as set forth above. Boushy does not teach *wherein the first number of points awarded and the additional points awarded are doubled for the player during a designated time period when either of the first or at least one second game is played*. However, since a casino would want to provide an incentive for a player to visit and play again as soon as possible to increase the patronage at the venue by, for example, providing bonus points (see at least column 12, line 26 – 28), it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to add the instant limitation with the teachings of Boushy.

26. **Claim 10:** Boushy teaches the method of Claim 9 as set forth above. Boushy does not teach *where the designated time is on a weekday*. However, since a casino would want to provide an incentive for a player to visit and play again anytime and everyday in order to increase the patronage at the venue by, for example, providing bonus points (see at least column 12, line 26 – 28), it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to add the instant limitation with the teachings of Boushy.

27. **Claim 11:** Boushy teaches the method of Claim 9 as set forth above. Boushy does not teach *where the designated time is after midnight*. However, since a casino would want to provide an incentive for a player to visit and play again anytime and everyday in order to increase the patronage at the venue by, for example, providing

bonus points (see at least column 12, line 26 – 28), it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to add the instant limitation with the teachings of Boushy.

28. **Claim 12:** Boushy teaches the method of Claim 9 as set forth above. Boushy does not teach *where the designated time is on a birthday of the player*. However, since a casino would want to provide an incentive for a player to visit and play again anytime and everyday in order to increase the patronage at the venue by, for example, providing bonus points (see at least column 12, line 26 – 28), it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to add the instant limitation with the teachings of Boushy.

29. **Claim 13:** Boushy teaches the method of Claim 1 as set forth above. Boushy does not teach *wherein the player can reach up to eighteen total reward levels*. However, Boushy teaches a plurality of rewards based on the betting activity of the player (see at least column 1, lines 15-18). Therefore, since the instant limitation provides for a plurality of rewards without any unexpected results (see MPEP 2144.04 VI B), it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to add the instant limitation with the teachings of Boushy.

30. **Claim 15:** Boushy teaches the system of Claim 14 as set forth above. Boushy does not teach *wherein said compensation machine depicts a photo of gifts available at various ones of the plurality of reward levels*. However, Boushy discloses a reward system to players wherein points can be redeemed for gifts and services as part of a casino's promotional scheme (see at least column 3, lines 8 – 22). Therefore, since

depicting photos of gifts available to players aids in furthering a promotion, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to add the instant limitation with the teachings of Boushy.

31. **Claim 16:** Boushy teaches the system of Claim 14 as set forth above. Boushy does not teach *wherein said compensation machine includes a redeem button that the player actuates after reaching one of said plurality of reward levels to obtain a gift receipt*. However, Boushy discloses a reward system wherein points can be redeemed for gifts and services as part of a casino's promotional scheme (see at least column 3, lines 8 – 22) by, for example, obtaining a comp voucher (see at least column 10, lines 47 – 50). Therefore, since a redeem button is placed on a machine for casino efficiency and customer convenience, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to add the instant limitation with the teachings of Boushy.

Conclusion

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Boushy, Patent No. US 6,003,013 issued on 14 December 1999 which teaches customer worth differentiation by selective activation of physical instrumentalities within the casino.
- Fertitta, III et al., Patent No. US 6,302,793 B1 issued on 16 October 2001 which teaches a multi-property player tracking system
- Beaulieu et al., Publication No. US 2004/0023709 filed on 5 August 2002 which teaches a gaming apparatus and gaming method
- Webb et al., Publication No. US 2003/0060277 filed on 3 September 2002 which teaches a gaming device with an increasing goal advancement game
- D'Amico et al., Publication No. US 2004/0077408 A1 filed on 21 October 2002 which teaches a gaming award method and apparatus


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dalpreet S. Saluja whose telephone number is (571) 270-1834. The examiner can normally be reached on Monday-Thursday, 7:30AM-5PM est, ALT Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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10/16/2007